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August 3, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re:	Application Serial No.:	09/505,594
	Appellants:	Jay Paul Drummond, et al.
	Filing Date:	February 16, 2000
	Confirmation No.:	5969
	Title:	Method And System For Connecting Services To Automated Transaction Machine
	Docket No.:	D-1120 R1

Sir:

  Please find enclosed Appellant's Reply Brief pursuant to 37 C.F.R. § 41.41 for filing in the above-referenced application.

         Very truly yours,

         Ralph E. Jocke
         Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

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Ralph E. Jocke

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	)	
Jay Paul Drummond, et al.	)	
	)	Art Unit **3624**
Serial No.: **09/505,594**	)	
	)	
Confirm. No.: **5969**	)	
	)	
Filed: **February 16, 2000**	)	Patent Examiner
	)	**Narayanswamy**
For: **Method And System For**	)	**Subramanian**
Connecting Services To An	)	
Automated Transaction Machine	)	

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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The Reply Brief is in response to the Examiner's Answer ("Answer") dated June, 8, 2005.

In the Answer a new ground of rejection appears to have been presented. Appellants continue to respectfully submit that the claims are allowable. It is requested that the Appeal continue.

GROUPING OF CLAIMS

The Answer (at page 2) asserts that the rejection of claims 1-11, 45 and 46 stand or fall together because Appellants' Brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. Appellants disagree.

The Examiner has referenced the old rule (37 CFR 1.192(c)(7)). However, Appellants' Appeal Brief was filed in conformance with the new rule 37 C.F.R. § 41.37, which does not require a claim grouping statement.

The Appeal Brief presents for each respective separate claim a corresponding respective separate argument as to why the claim is patentable over the applied reference. The Appeal Brief explains how each claim recites additional features of the invention which distinguish the claim over every other pending claim, and establishes that each claim recites at least one element, combination of elements, or step not found or suggested in the applied reference, which patentably distinguishes the claim.

Appellants respectfully request that the arguments presented in the Appeal Brief for each of the claims be considered individually.

STATUS OF CLAIMS

Claims 1-54 are pending in the Application.

Claims rejected:	1-11, 45 and 46
Claims allowed:	none
Claims confirmed:	none
Claims withdrawn:	12-44 and 47-54
Claims objected to:	none

Claims canceled: none

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1-11, 45 and 46 are unpatentable under 35 U.S.C. §

103(a) over Coutts, et al., U.S. Patent No. 6,311,165 ("Coutts").

Additional Comment 1

To support the "Official Notice" assertions used as a basis for rejecting at least claims 1-

9 and 46 over Coutts, the Examiner's Answer discusses (at page 8, lines 3-11; page 9, lines 4-12)

the additional references of David Clarke (Pages 16-17), and "Jini Device Architecture

Specification Reference," Sun Microsystems, January 25, 1999 pages 6-9.

However, it is unclear from the Examiner's Answer, whether the Office regards these

references as prior art. Also, the Examiner's Answer does not specifically reject claims 1-11, 45

and 46 over Coutts in view of Clarke and/or Sun Microsystems reference. No new ground of

rejection is indicated in the Answer.

Although the Examiner's Answer is unclear in this regard, Appellants do not wish to

delay consideration of the Appeal by the Board. Therefore Appellants will respond to the

assertions in the Answer regarding Clarke and the Sun Microsystems reference as though they

correspond to new grounds of rejection such as: Claims 1-11, 45 and 46 are unpatentable under

35 U.S.C. § 103(a) over Coutts in view of Clarke and/or Sun Microsystems.

Thus, it is presumed that additional grounds to be reviewed in this appeal are:

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Whether Appellants' claims 1-11, 45 and 46 are unpatentable under 35 U.S.C. § 103(a) over Coutts in view of Clarke and/or Sun Microsystems.

However, as the Examiner's Answer does not include a designated new ground of rejection, Appellants are not required to comply with 37 CFR §41.39(b)(2) in connection with this Reply Brief.

ARGUMENT

Appellants' Appeal Brief filed on October 27, 2002 is incorporated herein by reference. The Answer includes a "Grounds of Rejection" section beginning on page 3. All of the grounds of rejection included in this section of the Answer are substantially identical to those previously presented in the Office Action dated August 10, 2004.

Appellants respectfully submit that these rejections have already been fully addressed in Appellants' Appeal Brief. Please refer to Appellants' previous arguments in the Appeal Brief regarding all the issues of record.

Response to Presumed New Grounds of Rejection in Answer

The presumed additional 35 U.S.C. § 103(a) Rejections

Claims 1-11, 45 and 46 are presumed to have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Coutts in view of Clarke and/or Sun Microsystems. These rejections are respectfully traversed. Neither Clarke nor Sun Microsystems have an effective date prior to the effective filing date of the present invention.

Claim 1

The Examiner's Answer acknowledges (at page 7, line 22 to page 8, line 3) that Coutts does not teach the feature recited in claim 1 of "the second transaction function device is operative to communicate a device driver from the second transaction function device to the data store for storage in the data store." However, the Answer continues to stand by the Examiner's "Official Notice" assertion to provide the admittedly missing feature recited in claim 1. Further the Answer points to pages 16-17 of Clarke and pages 6-8 of the Sun Microsystems reference to support the Official Notice assertions. Appellants disagree that these newly cited references support the Answer's Official Notice assertions and/or provide a prior art teaching, suggestion or motivation to modify Coutts to include this missing feature.

The present application claims the benefit of U.S. Provisional Patent Application No. 60/120,506 filed February 17, 1999 pursuant to 35 U.S.C. 119(e), and the rejected claims are fully supported by this provisional patent application. Clarke appears to have been first published in or after the April-June 1999 time frame. Thus Clark does <u>not</u> qualify as prior art and cannot be used as a basis to support the Answer's "Official Notice" assertions and/or the Answer's presumed new grounds of rejection based on Coutts in view of Clarke and/or Sun Microsystems.

In addition the Answer provides no showing or argument that the Sun Microsystems reference is prior art. Although the Sun Microsystems reference includes a Revision 1.0 date of January 25, 1999, neither the Sun Microsystems reference nor the Answer provide any evidence whatsoever as to when the Sun Microsystems reference was made publicly available. For example, neither the Sun Microsystems reference nor the Answer provides any indication as to

when this reference was included in a published journal or was publicly available on an Internet web page. The Revision 1.0 date of January 25, 1999 may be earlier than Appellants' earliest priority date of February 17, 1999; however, a revision date only suggests the date the particular revision was completed. As revisions of documents can be done privately and non-publicly, Appellants respectfully submit that such a revision date does not provide evidence of a publication of the reference. Any document can be revised internally by a company numerous times and be associated with numerous revision dates prior to the document being published or being publicly available. The Office has provided no evidence of the Sun Microsystems reference being published or publicly available prior to Appellants' earliest priority date. As a result, the Office has failed to establish that this reference constitutes prior art to Appellants' invention. Appellants hereby challenge the Office to make a showing that the Sun Microsystems reference is prior art to the present invention, and in the absence of such a showing request immediate allowance of the Application.

Appellants have attempted to determine the earliest publication date for the Sun Microsystems reference. Appellants have uncovered an Acrobat® PDF file entitled "deviceArch.pdf" which corresponds to the Sun Microsystems reference cited in the Examiner's Answer and which is available for download from the Internet. Appellants have attempted to locate the earliest existing copy of a web page which links to this PDF file. At one point, (although not as of July 25, 2005) there appears to have been a copy of the Sun Microsystems reference PDF file available at the URL: "http://www.sun.com/jini/specs/deviceArch.pdf." Because the U.S. Patent Office often relies on the "WayBackMachine" at the web site "www.archive.org" to corroborate that a particular web page was accessible on the Internet at a

particular prior art date, Appellants entered the URL:

"http://www.sun.com/jini/specs/deviceArch.pdf" into the "WayBackMachine." The earliest date

at which the PDF file corresponding to the Sun Microsystems reference was recorded by the

"WayBackMachine" as being publicly available on the Internet was April 21, 2000, which is after

Appellants' priority and filing dates. Also, for the years 1996-1999, the "WayBackMachine"

shows "0 pages" corresponding to this URL. The failure by the Office to cite any evidence from

its favorite source for Internet documents, the "WayBackMachine", to show this reference was

available publicly prior to Appellants' priority date, constitutes an admission by the Office that

this reference was not publicly available prior to Appellants' effective filing date.

Thus, the Sun Microsystems reference has not been shown to qualify as prior art and

therefore cannot be used as a basis to support the Answer's "Official Notice" assertions and/or the

Answer's presumed new grounds of rejection based on Coutts in view of Clarke and/or Sun

Microsystems.

In addition, even if it were possible for the Sun Microsystems reference to qualify as prior

art (which it does not), the Examiner's Answer has still failed to show any prior art teaching,

suggestion, or motivation to combine this reference with Coutts to provide Coutts with the

admitted missing feature recited in claim 1.

For example, the Sun Microsystems reference does not disclose or suggest an automated

transaction machine, which in the exemplary embodiment described in the Specification

comprises an Automated Teller Machine (ATM). Further the Sun Microsystems reference does

not disclose or suggest using the described Jini™ architecture in an automated transaction

machine or an ATM. Similarly, Coutts does not disclose or suggest using the Jini™ architecture

described in the Sun Microsystems reference. Also Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the Sun Microsystems references include a prior art teaching, suggestion or motivation to combine the references in a manner which includes each and every feature and relationship recited in claim 1.

The Answer asserts that a motivation to combine can be found in Coutts (Column 3, lines 18-26) where it is allegedly suggested that each of the operating modules (peripheral devices) can be conveniently and independently updated using JAVA executable program code. However, neither this portion of Coutts nor any other portion of Coutts, discloses or suggests using the Jini™ architecture described in the Sun Microsystems reference in an ATM to provide the admitted missing feature recited in claim 1.

The alleged motivation to update JAVA executable code in the peripheral devices of Coutts is asserted in the Answer to be Coutts' teaching of having the peripheral devices of an ATM (11) (Figure 1) individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). As discussed in the Appeal Brief, Coutts teaches a system which has the opposite direction of communication compared to the recited invention. In Coutts, devices only download software from a server. Coutts does not disclose or suggest uploading software from a device to the server or any other data store as recited in Appellants' claim. Further Coutts specifically teaches away from communicating device drivers from devices to a data store, by expressly teaching that "software modules are not first downloaded to an intermediate location and then copied to the peripherals [3]64 from the intermediate location" (Column 21, lines 25-27). Thus, nowhere in Coutts is it

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disclosed or suggested that the server of Coutts or any other data store, receives device drivers for a transaction function device from the transaction function devices.

Given that Coutts expressly teaches away from the feature recited in claim 1 that the Office admits is missing from Coutts, Appellants respectfully submit that there is no motivation provided by Coutts to cause one skilled in the art of automated transaction machines or ATMs to look to the Sun Microsystems reference to create an embodiment which conflicts with the specific teachings of Coutts. Therefore, it would not have been obvious to one having ordinary skill in the art to have modified Coutts in view of the Sun Microsystems reference to have produced the claimed invention.

Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 1 and dependent claims 2, 3, 6-9 and 46 over Coutts in view of the Official Notice assertion and/or in view of the Clarke and/or Sun Microsystems references are improper and should be withdrawn.

Claim 4

The Appeal Brief includes a detailed discussion of the features, relationship and steps recited in claim 4 and dependent claim 5 which are missing from Coutts. Please refer to the Appeal Brief with respect to the rejection of the claims in view of Coutts alone.

In addition, with respect to claim 4, the Examiner's Answer states (at page 9, lines 1-3) that Coutts does not teach the feature recited in claim 4 of "a second transaction function device is operative to communicate a device driver from the second transaction function device to the data store for storage in the data store." However, claim 4 does not recite this exact language, rather this language is recited in claim 1. Nevertheless, claim 4 recites the similar feature missing from Coutts of "wherein the device computer processor associated with the second

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transaction function device is operative to cause the driver to be stored in the data store".
Appellants presume that this feature recited in claim 4 was intended to be acknowledged as
missing from Coutts, because it clearly is.

With respect to this feature recited in claim 4, the Answer appears to continue to stand by
the Examiner's unfounded "Official Notice" assertion to provide this feature recited in claim 4
that is not found in Coutts. Further the Answer points to pages 16-17 of Clarke and pages 6-8 of
the Sun Microsystems reference to support the Official Notice assertions. Appellants disagree
that these newly cited references support the Answer's Official Notice assertions and/or provide a
prior art teaching, suggestion or motivation to modify Coutts to include this missing feature.

As discussed previously with respect to claim 1, Clarke appears to have been published
in or after the April-June 1999 time frame. Thus Clark does not qualify as prior art against the
recited invention and cannot be used as a basis to support the Answer's "Official Notice"
assertions and/or the Answer's presumed new grounds of rejection based on Coutts in view of
Clarke and/or Sun Microsystems.

In addition, the Answer provides no showing or argument that the Sun Microsystems
reference is prior art. Indeed, it is not prior art. Thus, the Sun Microsystems reference cannot be
used as a basis to support the Answer's "Official Notice" assertions and/or the Answer's
presumed new grounds of rejection based on Coutts in view of Clarke and/or Sun Microsystems.

In addition, even if it were possible for the Sun Microsystems reference to qualify as prior
art (which it does not), the Answer has failed to show a prior art teaching, suggestion, or
motivation to combine this reference with Coutts to provide Coutts with the admitted missing
feature recited in claim 4.

As discussed previously with respect to claim 1, the Sun Microsystems reference does not disclose or suggest an automated transaction machine or an ATM. Further the Sun Microsystems reference does not disclose or suggest using the described Jini™ architecture in an automated transaction machine or an ATM. Similarly, Coutts does not disclose or suggest using the Jini™ architecture described in the Sun Microsystems reference. Also Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the Sun Microsystems reference include a prior art teaching, suggestion or motivation to combine the references in a manner which includes each and every feature and relationship recited in claim 4.

The Answer asserts that a motivation to combine these steps can be found in Coutts (Column 3, lines 18-26) where it is allegedly suggested that each of the operating modules (peripherals devices) can be conveniently and independently updated using JAVA executable program code. However, neither this portion of Coutts nor any other portion of Coutts discloses or suggests using the Jini™ architecture described in the Sun Microsystems reference in an ATM to provide the admitted missing feature recited in claim 4.

The alleged motivation to update JAVA executable code in the peripheral devices of Coutts is asserted in the Answer to be Coutts' specific teaching of having the peripheral devices of an ATM (11) (Figure 1) individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). As discussed in the Appeal Brief, Coutts teaches a system which has the opposite direction of communication compared to the recited invention. In Coutts, devices only download software from a server. Coutts does not disclose or suggest that a "device computer processor associated with" one of its

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peripheral devices "is operative to cause the driver to be stored in the data store." Further Coutts specifically teaches away from devices causing device drivers to be stored in a data store, by expressly teaching that "software modules are not first downloaded to an intermediate location and then copied to the peripherals [3]64 from the intermediate location" (Column 21, lines 25-27).

Thus, given that Coutts teaches away from the admitted missing feature recited in claim 4, Appellants respectfully submit that there is no motivation provided in Coutts to cause one skilled in the art of automated transaction machines or ATMs to look to the Sun Microsystems reference to create an embodiment which conflicts with the specific teachings of Coutts. Therefore, it would not have been obvious to one having ordinary skill in the art to have modified Coutts in view of the Sun Microsystems reference (if it were prior art, which it is not) to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 4 and dependent claim 5 over Coutts in view of the Official Notice assertion and/or in view of the Clarke and/or Sun Microsystems reference are improper and should be withdrawn.

Claim 10

The Appeal Brief includes a detailed discussion of the features and relationships recited in claim 10 and dependent claims 5, 11, and 45 which are missing from Coutts. Please refer to the Appeal Brief with respect to the rejection of the claims in view of Coutts alone.

In addition, Appellants disagree with the Answer's assertion at page 9, line 20, that the Abstract of Coutts discloses steps wherein the first transaction function device is operative to communicate a device driver from the first transaction function device to the at least one other transaction function device; and the at least one of the device computers of the at least one other

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transaction function device, is operative responsive to the device driver communicated from the first transaction function device, to communicate with the first transaction function device. Nowhere in the Abstract or elsewhere does Coutts disclose or suggest these features.

Although the Abstract teaches that "the individual peripheral devices can be connected to each other over the link to enable them to communicate directly with each other on a peer-to-peer basis," such a teaching does not disclose or suggest communicating a device driver between individual devices. Rather Coutts only teaches having the peripheral devices of an ATM (11) (Figure 1) individually download software modules from a remote server (16) (Column 3, lines 60-63; Column 8, lines 51-52; Column 9, lines 45-46). Nowhere does Coutts disclose or suggest that the "peer-to-peer basis" of communication includes communicating device drivers between peripheral devices.

At page 10, line 4, the Answer appears to suggest that the "Official Notice" assertions argued with respect to the rejections of claims 1-9, and 46 in combination with Coutts apply to claims 10, 11, and 45 as well. However as discussed previously, the newly cited references of Clarke and the Sun Microsystems are not prior art and/or do not support the Answer's Official Notice assertions. Further Appellants disagree that Coutts in view of Clarke and/or the Sun Microsystems reference provide any prior art teaching, suggestion or motivation to modify Coutts to include the features and relationships recited in claims 10, 11, and 45.

As discussed previously with respect to claim 1, the Sun Microsystems reference is not prior art and does not disclose or suggest an automated transaction machine or an ATM. Further the Sun Microsystems reference does not disclose or suggest using the described Jini™

architecture in an automated transaction machine or an ATM. Similarly, Coutts does not disclose or suggest using the Jini™ architecture described in the Sun Microsystems reference. Also Coutts does not disclose or suggest using the Jini™ architecture in an automated transaction machine or ATM. Thus neither Coutts nor the Sun Microsystems reference include a prior art teaching, suggestion or motivation to combine the references in a manner which includes each and every feature and relationship recited in claim 10.

As discussed previously, Coutts teaches a system which has the opposite direction of communication compared to the recited invention. In Coutts, devices only download software from a server. Coutts does not disclose or suggest that one of its peripheral devices "is operative to communicate a device driver from" the peripheral device to "at least one other" peripheral device.

Thus, given that Coutts specifically teaches the advantages of directly downloading software modules from a remote server to the peripheral devices (Column 3, lines 26-37), Appellants respectfully submit that there is no motivation provided in Coutts to cause one skilled in the art of automated transaction machines or ATMs to disregard the specific teachings of Coutts and to look to the Sun Microsystems reference (which is not prior art in any event) to create an embodiment which communicates device drivers between devices rather than from a remote server. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections of claim 10 and dependent claims 11, and 45 over Coutts in view of the Official Notice assertion and/or in view of the Clarke and/or Sun Microsystems reference are improper and should be withdrawn.

Response to New Arguments in Answer

The Answer includes a "Response to Argument" section beginning on page 7. The discussion of the Examiner's "Official Notice" assertions and presumed new grounds of rejection included in this section have been discussed previously. They are not supported and are without merit. In addition, Appellants do not agree with the Examiner's summary of Appellants' arguments. Also Appellants disagree that Coutts teaches all of the features recited in the claims expect for those features specifically admitted in the Answer as being missing.

Further, the Examiner's Answer does not argue that either Clarke or the Sun Microsystems references show any of the other features and relationships pointed out in the Appeal Brief as missing from Coutts, and which are expressly recited in claims 1-11, 45 and/or 46. Thus, Appellants respectfully submit that the Examiner's Answer and prior Actions have not established *prima facie* obviousness with respect to the pending claims.

CONCLUSION

Appellants have responded to the claim rejections (as best understood) in spite of the Office's failure to clearly state that the Answer's reliance on Clarke and the Sun Microsystems reference correspond to a new ground of rejection. The evidence of record and the statutory tests all establish that Appellants' claimed invention is patentable. Allowance of all the pending claims is respectfully requested.

Respectfully submitted,

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